



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2010 TMOB 204
Date of Decision: 2010-11-25

**IN THE MATTER OF AN OPPOSITION
by Ronald and Nancy Mallette to
application No. 1,313,831 for the trade-
mark BLOOMFIELD MALL in the name
of Maritime Imports Inc**

[1] On August 22, 2006, Maritime Imports Inc [sic] (the Applicant) filed an application to register the trade-mark BLOOMFIELD MALL (the Mark) based on proposed use of the Mark in Canada in association with: (1) development, operation and management of an integrated project namely development, operation and management of apartment buildings, hotels, office buildings, parking facilities, restaurants and (2) the wholesaling and retailing of produce, fruits and beverages. The Applicant has disclaimed the right to the exclusive use of the word MALL apart from the Mark.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of July 25, 2007.

[3] On December 14, 2007, Ronald and Nancy Mallette carrying on business as Bloom Field Farm (the Opponent) filed a statement of opposition, which pleaded a single ground of opposition, pursuant to s. 16 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act). The exact words of the pleaded ground are reproduced below.

- (a) That the applicant is not the person entitled to registration the trade-mark pursuant to sec. 16 of the Trade-marks Act because at the date of filing of applicant's application, namely August 22, 2006, the trade-mark was confusing

with a trade-mark that had been previously used in Canada. The latter trade-mark is the subject of application no. 1,340,626 filed in the Canadian Intellectual Property Office on March 16, 2007. A copy of the latter application is attached hereto.

[4] The attachment to the statement of opposition provides the particulars of application No. 1, 340,626, which is an application filed by the Opponent on March 16, 2007 for the trade-mark BLOOM FIELD. Such application is based in part on proposed use but claims that the Opponent has used BLOOM FIELD as a trade-mark in Canada in association with

- i) perennial plants, landscaping, the planting of floral beds and arrangements for display at the Opponent's place of business and elsewhere, and the planting of floral beds and arrangements since May 2004;
- ii) vegetables and fruit since June 2005;
- iii) cut flowers and hanging baskets of flowers since May 2006.

[5] Although the Opponent's pleading does not refer to a specific paragraph of s. 16, it is clear that the ground of opposition relies upon s. 16(3)(a).

[6] The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[7] In support of its opposition, the Opponent filed a statutory declaration of Nancy Mallette.

[8] In support of its application, the Applicant filed an affidavit of its trade-mark agent, Oliver Hunt.

[9] No cross-examinations were conducted.

[10] Both parties filed a written argument.

[11] Only the Opponent made submissions at an oral hearing. At the oral hearing, the Opponent's agent advised that the opposition was being withdrawn insofar as the following services are concerned: development, operation and management of an integrated project namely development, operation and management of apartment buildings, hotels, office buildings,

parking facilities, restaurants. Thus, the opposition is now only concerned with the following services of the Applicant: the wholesaling and retailing of produce, fruits and beverages.

[12] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

[13] In order to meet its initial burden, the Opponent must show that it used BLOOM FIELD as a trade-mark in association with the pleaded wares/services prior to the filing date of the Applicant's application, namely August 22, 2006. In addition, the Opponent must show that it had not abandoned its mark when the Applicant's Mark was advertised (s. 16(5)).

[14] The Opponent's evidence does not meet its initial burden for the reasons set out below.

[15] Ms. Mallette asserts that she and Ronald Mallette have continuously used the trade-mark BLOOM FIELD in Canada in connection with their business which involves the wholesaling and retailing of, among other wares, perennials (since June 2003); hanging baskets, herbs, garden accents and accessories, bottled water, iced tea, pop (since May 2004); and fruits, vegetables, trees and shrubs (since May 2005). She states that "[s]ales were mostly over the counter at our outlet in the Municipality of Clarington but some of our products were ordered by our customers over the phone, by mail and by other means." However, Ms. Mallette has not shown how the BLOOM FIELD mark was associated with any of such wares. In addition, I note that the Opponent did not rely on any wholesale or retail services in its statement of opposition.

[16] Section 4 of the Act sets out what qualifies as "use" of a trade-mark. The portions relevant to the case at hand are s. 4(1) and (2), which read:

4. (1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

(2) A trade mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of such services.

[17] Ms. Mallette has not provided any evidence that shows that BLOOM FIELD has been associated with any wares sold by the Opponent in the manner required by s. 4(1) as of any date. Regarding services, she has not provided any evidence that shows the display of BLOOM FIELD in the performance or advertising of any of the services referred to in the statement of opposition.

[18] Ms. Mallette's exhibits may be summarized as follows.

[19] Exhibits 03-1, 03-2, 04-1 through 04-3, 05-1 through 05-13, 06-1 through 06-6, and 06-8 through 06-11 are copies of invoices sent to the Opponent by suppliers in 2003-2006. The only place that the words BLOOM FIELD appear on these invoices is as part of the name of the purchaser/recipient; all of the invoices are addressed to Bloom Field Farm (or minor variations of that name), with the exception of invoice 04-1 which is addressed to Bloom Field Nursery. Even if I accept Ms. Mallette's statement that the various wares listed in the invoices were re-sold by the Opponent to customers, there is no evidence that the trade-mark BLOOM FIELD was associated with such wares when they were sold by the Opponent.

[20] Although Ms. Mallette identifies Exhibit 06-7 as a copy of an invoice sent to the Opponent by a supplier, it appears to be an invoice issued by Bloom Field Farm to a third party, Kamstra Landscaping. The invoice is dated 05/18/2006; it does not refer to a shipping date and does not indicate that the invoice accompanied the wares. (As set out in *Riches, McKenzie & Herbert v. Pepper King Ltd.* (2000), 8 C.P.R. (4th) 471 (F.C.T.D.), the Registrar cannot assume that invoices accompany wares in the absence of evidence to this effect.) The only place that the words BLOOM FIELD appear on this invoice is as part of the issuer's name. The invoice displays BLOOM FIELD FARM at the top left hand corner above an address. The words BLOOM FIELD are not set out in any way to distinguish them from the word FARM, with the result that it is BLOOM FIELD FARM, not BLOOM FIELD, that is being used. Moreover, the use is as a trade-name, not a trade-mark. For all of the foregoing reasons, Exhibit 06-7 does not assist the Opponent in proving prior use of its BLOOM FIELD trade-mark.

[21] Exhibits EM1 through EM6 are copies of emails dated February 2008 from customers of the Opponent; they are in the nature of testimonials. These emails postdate the material date and their content, including references to past events, are inadmissible hearsay. They therefore cannot serve to meet the Opponent's initial burden.

[22] At the oral hearing, the Opponent submitted that its initial burden can be met through the Applicant's evidence, in particular Exhibit E1 to the Hunt affidavit (the exhibit alleges to be a copy of the Opponent's website from May 20, 2004 obtained from a search on <http://bloomfieldfarm.ca> from "Wayback Machine"). In its written argument, the Opponent took the position that because Mr. Hunt is the Applicant's agent, his entire affidavit should be disregarded in accordance with *Cross-Canada Auto Body Supply (Windsor) Ltd. v. Hyundai Auto Canada* (2006), 53 C.P.R. (4th) 286 (F.C.A.), affg. (2005), 43 C.P.R. (4th) 21 (F.C.). Nevertheless, at the oral hearing the Opponent's agent took the view that admissions against interest in Mr. Hunt's evidence could be considered.

[23] I am not aware of any case law that says that an Opponent can meet its initial burden under s. 16(3)(a) by means of the Applicant's evidence. It is true that under certain grounds of opposition, namely grounds pleaded pursuant to s. 30(b) or 30(e), an opponent may rely on the applicant's evidence to meet its initial burden. However, this exception applies in such cases because the facts regarding the applicant's use of the applicant's mark or the applicant's intent to use the applicant's mark are particularly within the knowledge of the applicant (see *Labatt Brewing Company v. Molson Breweries, Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.); *Molson Canada v. Anheuser-Busch Inc.* (2003), 29 C.P.R. (4th) 315 (F.C.T.D.); *Canadian National Railway Co. v. Schwauss* (1991), 35 C.P.R. (3d) 90 at 94 (T.M.O.B.); and *Green Spot Co. v. J.B. Food Industries* (1986), 13 C.P.R. (3d) 206 at 210-211 (T.M.O.B.)). Clearly, such a rationale does not apply when one is concerned with evidence of the opponent's use. I see no reason why an opponent's initial burden should be as light under s. 16(3)(a) as it is under s. 30(b) and 30(e).

[24] I therefore am dismissing the s. 16(3)(a) ground of opposition on the basis that the Opponent's evidence has not satisfied the Opponent's initial burden.

[25] In the event that I am wrong in finding that an opponent cannot rely on the applicant's evidence to meet its initial burden under s. 16(3)(a), then the ground would still be dismissed on the basis that the Opponent has not met its initial because, at best, Mr. Hunt's Exhibit E1 shows use of BloomField Farm, not the Opponent's BLOOM FIELD trade-mark.

[26] As the Opponent has not met its initial burden with respect to the sole ground of opposition, pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

Jill W. Bradbury
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office